

Application Ser. No.: 10/613,588
Filing Date: July 03, 2003
Examiner: Desai, Rita

Remarks

In the Final Office Action, dated June 21, 2005, the Examiner noted that claims 1 to 24 are pending in the application; claims 5-10 and 14-24 are withdrawn from consideration (however, in the advisory action the Examiner has noted incorrectly that claims 6-16 and 18-24 have been withdrawn); claims 1, 2, 4, 11 and 12 are rejected; and that claims 3 and 13 are objected to. Applicants had amended, claims 1, 11 and 14, and claims 4 and 17 had been cancelled without prejudice or disclaimer of the subject matter contained therein in their After Final response dated, September 20, 2005.

However, the Office issued an Advisory Action on September 28, 2005 stating that the amendments failed to place the application in condition for allowance. Specifically, the Examiner noted that there are 112 issues in case of rejoinder, hence not rejoined. More specifically, the Examiner noted that the Applicants should also clearly state the proviso in claim 1. In further clarification of this issue, the undersigned initiated a teleconference with the Examiner on October 3, 2005. At which time, the Examiner stated that the proviso in claim 1 is confusing as to R1 and suggested that its definition be stated only once and all of the variables of A be listed in sub-paragraph fashion. The undersigned acknowledges with much appreciation the courtesies extended by the Examiner. As a result, by this amendment the proviso in claim 1 has been amended as suggested by the Examiner to remove any confusion it might have caused. Similarly, the proviso in claims 11 and 14 has been amended. Thus, claims 1-3, 5-16 and 18-24 are pending in the application. No new subject matter has been inserted through these amendments. Specifically, claims 1, 11 and 14 have been amended to correct inadvertent error occurred during the previous amendment while providing proper proviso, which is further discussed in detail below. Claim 14 has also been amended to correct certain of the errors from the previous amendment in that the definition of heterocycle at page 24 had not been amended previously and has been amended now through this amendment. All of the amendments are fully supported by the specification. The Examiner's rejections are respectfully traversed below.

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Election/Restrictions and Rejoinder of Claims

The Examiner has made final the four way restriction imposed on this application and has withdrawn claims 5-10 and 14-24, as noted above. However, Applicants point out that under current Office Policy and pursuant to MPEP 821.04, the claims 5-10 and 14-24 must be rejoined as they all relate to use of the compound of claim 1 once claim 1 is found allowable. As noted in MPEP 821.04:

"However, if *applicant elects claims directed to the product*, and a product claim is subsequently found allowable, *withdrawn process claims* which depend from or otherwise include all the limitations of the allowable product claim *will be rejoined*. Where the application as originally filed discloses the product and the *process for making and/or using the product*, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicant may present claims directed to the *process of making and/or using the patentable product* by way of amendment pursuant to 37 CFR 1.121. (emphasis added)

Please note that claim 5 is a pharmaceutical composition claim, which directly depends upon claim 1 incorporating all of the limitations of claim 1. Similarly, claims 6-10 and 14-24 recite various methods of using the compound of claim 1 incorporating all of the limitations of claim 1. In fact, claims 6-10 depend directly or indirectly upon claim 1 and recite further limitations of its use. Whereas independent claim 14 recites a method of use of compound of formula (I) having the scope as that recited in claim 1. Dependent claims 15-24 depend directly upon claim 14 and recite additional limitations. Therefore, claims 5-10 and 14-24 must be rejoined pursuant to provisions of MPEP 821.04 and such an action is earnestly requested.

Withdrawal of Rejection Under 35 U.S.C. § 112, Second Paragraph

Applicants note with much appreciation withdrawal of rejection of claims 1-2, 5, 11 and under 35 U.S.C. § 112, second paragraph.

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Withdrawal of Rejection Under 35 U.S.C. § 102(b)

Applicants note with much appreciation withdrawal of rejection under 35 U.S.C. § 102(b) as being anticipated by Tully in view of Applicants amendment of the claims.

Withdrawal of Rejection Under 35 U.S.C. § 102(e)

Applicants note with much appreciation withdrawal of rejection under 35 U.S.C. § 102(e) as being anticipated by Flohr in view of Applicants amendment of the claims.

Withdrawal of Rejection Under Double Patenting

Applicants note with much appreciation withdrawal of rejection under double patenting in view of Applicants timely filed terminal disclaimer.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 1, 2, 11 and 12 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

In particular, the Examiner alleges that the new subgenus of compounds in the proviso of claims 1 and 11 is not described in the specification. The Examiner further notes that same rejection applies to claims 2 and 12 as they respectively depend from claims 1 and 11.

By way of this amendment claims 1 and 11 have been amended to remove inadvertently added hydrogen within the definition of R² as defined in the proviso. Please note that R² as defined in the specification did not include hydrogen, please see specification at various places particularly at page 3, line 32 to page 4, line 13. Thus, it is respectfully submitted that claims 1 and 11, as amended, fully satisfy the requirements of 35 U.S.C. § 112, first paragraph as well as the dependent claims 2 and 12. Accordingly, withdrawal of rejection as to claims 1, 2, 11 and 12 is respectfully requested.

Rejection Under 35 U.S.C. § 103(a)

Claim 4 stands rejected as being unpatentable over Tully (GB 2185255).

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As noted, claim 4 has been canceled without prejudice thus rendering this rejection moot. Thus, withdrawal of rejection as to claim 4 is respectfully requested.

Rejection Under 35 U.S.C. § 103(a)

Claim 4 stands rejected as being unpatentable over Flohr (U. S. Pat. No. 6,841,556).

As noted, claim 4 has been canceled without prejudice thus rendering this rejection moot. Thus, withdrawal of rejection as to claim 4 is respectfully requested.

Allowable Subject Matter

Claims 3 and 13 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As noted above, independent claims 1 and 11 have been amended to place them in condition for allowance. Please note that claims 3 and 13 depend directly upon claims 1 and 11 respectively, and recite specific compounds within the scope of either claims 1 and 11. As argued above, since we believe that claims 1 and 11, as amended, are in condition for allowance, so are claims 2, 3 and 12. Thus, claims 1-3 and 11-13 are in condition for allowance. Furthermore, claim 14 has been amended to place it in condition for allowance. As further noted above it is respectfully submitted that claims 5-10 and 14-16 and 18-24 should be rejoined pursuant to the provisions of MPEP 821.04, and therefore, claims 1-3, 5-16 and 18-24 are in condition for allowance and such an action is earnestly requested.

Conclusions

In view of the above Remarks, it is respectfully submitted that claims 1-3, 5-16 and 18-24 are now in condition for allowance and the early issuance of this case is respectfully requested. In the event the Examiner wishes to contact the undersigned regarding any matter, please call (collect if necessary) the telephone number listed below.

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As noted above, Applicants concurrently submit herewith a petition for one-month extension of time to make this RCE timely. Applicants request the Commissioner to charge both of these fees and any other fees that the Commissioner deems necessary due to this submission to Deposit Account No. 18-1982 for Aventis Pharmaceuticals Inc. Bridgewater, NJ. Please credit any overpayment to Deposit Account No. 18-1982.

Respectfully submitted,

October 6, 2005

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